

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 12, 2005. At the time of the Office Action, Claims 1-3, 8, 10, 19-21, and 26-29 were pending in this Application. Claims 4, 5, 9, 12, 13, 18, 22-25 and 30 were previously withdrawn due to an election/restriction requirement. Claims 6, 7, 11, and 14-17 were previously cancelled by Applicant without prejudice or disclaimer. Claims 1-3, 8, 10, 19-21, and 26-28 were rejected. Claims 20, 21 and 29 were objected to. Claims 1, 8, 10, and 19 have been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1, 2, 8, 10, 19-21, and 26-28 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends Claims 1, 8, 10, and 19 to overcome these rejections.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 3, 8, 10, 19, and 26-28 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,371,450 issued to Kazuo Hiraoka ("Hiraoka"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

Claims 1, 2, 3, 8, 10, 19, and 26-28 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,595,693 issued to Shigeru Fujita et al. ("Fujita et al."). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as

complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The present independent claim 1 includes the limitation

"detectors for detecting first and second variables generated during the operation of the machine, said variables fed to said control unit, said control unit comprising a first determination unit to receive said first variable and generate a first setpoint, a conversion unit for generating an intermediate setpoint from said first variable, said intermediate set point being corrected by the second variable to generate a second setpoint, wherein a machine control unit receives said first and second setpoints to generate a machine control parameter, wherein the drive advances a screw for driving an injection and generating an injection pressure, and wherein the first variable is a position of said drive and the second variable is said injection pressure."

Thus, the first variable is clearly defined as a position variable and the second variable as a pressure variable. The Examiner stated that Hiraoka discloses this limitation. Applicant respectfully disagrees. In particular, the Examiner stated in paragraph 11 of the above mentioned office action that Hiraoka discloses S_z as the first variable from which a first setpoint S_d is generated. The Examiner further stated that an intermediate setpoint S_y is also generated from the first variable. Then the Examiner stated that this intermediate setpoint S_y is corrected by a second variable, namely the pressure value provided by unit 18 which forms variable S_p . Applicant respectfully disagrees with such an analysis of the Hiraoka system. Fig. 3 of Hiraoka shows that the second variable S_p delivered by unit 18 is used to generate another intermediate setpoint S_q . However, this variable is never used to correct the first intermediate setpoint S_y . Rather either S_y or S_q are selected to form S_v . At best this variable S_p is used to correct another variable S_r . See Fig. 3 and associated description.

In paragraph 26 of the above mentioned office action, the Examiner further explains *"that Hiraoka discloses the detected pressure variable S_r being sent to the*

function unit 24-7 which is fed the velocity based on the position variable (Fig.2). Additionally, the detected pressure variable S_p is fed to the subtractor 30-1 (Fig.3)" Applicant respectfully submits that they cannot follow this analysis and its conclusion.

First, the Examiner now cites the pressure variable S_r as the second variable. However, in paragraph 11, the Examiner uses the signal from unit 18 as the pressure variable which results in signal S_p . In any case, neither S_r nor S_p are used to correct the intermediate setpoint.

Second, the Examiner cites circuit parts from Fig. 2 and circuit parts from Fig. 3 and, thus, seems to combine these circuits. Applicant would like to point out that Fig. 2 of Hiraoka refers to a prior art system whereas Fig. 3 of Hiraoka refers to Hiraoka's invention. These two systems are different and cannot be combined.

The same arguments presented with respect to claim 1 also apply to independent claims 3 and 10. These claims include besides further limitations a similar limitation as stated above.

In summary, Hiraoka lacks the limitation of claims 1, 3, and 10. Therefore, these claims are allowable over the prior art. Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claims to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and does not concede that the Examiner's proposed combinations are proper.

Also, Applicant added new claims 31 and 32. New independent claim 31 includes all the limitations of independent claim 10 and also limitations that refer to the functional units FB2, FB3, and FB4 of Fig. 2 of the present application. New dependent Claim 32 adds a limitation which refers to functional unit FB5 of Fig. 2. Applicant believes that these claims are also allowable.

Allowable Subject Matter

Applicant appreciates Examiner's consideration and indication that Claims 20 and 21 and 29 would be allowable if rewritten to overcome the rejections as set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims. As stated above, Applicant believes that all pending claims are allowable. Furthermore, because the independent claims are allowable, Applicant requests to reinstate the withdrawn claims which are dependent on the pending independent claims as these claims include all the limitations of the independent claims and include further limitations.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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§11.9(b)

Date: January 12, 2006

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